REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Typographical Error in Claim 1 on Pages 1-2 of Amendment dated March 17, 2003

Some text of Claim 1 was inadvertently omitted from the amendment dated March 17, 2003. Claim 1 is now corrected. A mark-up showing the corrections to claim 1 is attached.

The First Full Paragraph on Page 6 of the Office Action

In the first full paragraph on Page 6 of the Office Action, the Examiner states:

> "[T]he claims as now pending have a date no earlier than July 7, 1997 (claim 1 was amended in paper #23). No interference will be declared at this time because the claims as presented were not copied or presented prior to one year of the issue date of the Olson, Kirkendall, and Wheeler references."

For the record, Applicant would point out that the relevant provision of law, 35 USC § 135(b)(1) reads as follows:

> "A claim which is the same as, ***or for the same or substantially the same subject matter as,*** a claim of an issued patent may not be made in any application unless ***such a claim*** is made prior to one

year from the date on which the patent was granted. [Emphasis added.]"

The Examiner has taken the position that no interference is possible because the current claims were ***not actually filed*** until more than one year after the issue dates of the Olson, Kirkendall and Wheeler references. However, there is no requirement that ***the exact claim*** which is to be the basis of the interference must have been filed less than one year after the issue date of the interfering patent in order to be in interference with that patent. 35 USC § 135(b) speaks of "such ***a*** claim," which means not necessarily the same claim, but ***the same type of claim,*** i.e., one that is "the same as, or for the same or substantially the same subject matter." In other words, a claim that is filed more than one year after the issue date of a patent can still be in interference with that patent provided the applicant was claiming the "same or substantially the same subject matter" as any claim of the interfering patent less than one year after the issue date of the patent.

This view is confirmed by *Manual of Patent Examining Procedure* § 2307, which reads, in pertinent part, as follows:

"If the claim presented or identified as corresponding to the proposed count ***was added to the application by an amendment filed more than one year after issuance of the patent,*** or the application was not filed until more than one year after issuance of the patent (but the patent is not a statutory bar), then under the

> provisions of 35 U.S.C. 135(b), an interference will not be declared ***unless*** at least one of the claims ***which were in the application, [i.e., they need not be in the application now]*** or in a parent application, prior to the expiration of the one-year period was for "substantially the same subject matter" as at least one of the claims of the patent. [Again, emphasis added.]"

Thus, claims added more than one year after the issue date of a patent can still be put into interference with that patent under the appropriate circumstances. Consequently, the Examiner's position on this point is incorrect, and Applicant respectfully requests that he reconsider it. The Examiner may or may not determine that an interference with one or more the Olsen, Kirkendall and Wheeler references is appropriate. However, the Examiner should not have determined that an interference was impossible because the current claims were not filed until 1997. The fact is that the current claims are drawn to substantially the same subject matter as the original claims, and, therefore, the propriety of an interference with any of the Olsen, Kirkendall or Wheeler references must be decided on the basis of the original filing date of the application, not the filing date of the current claims.

Olsen, Kirkendall and Wheeler '467 were all issued less than one year prior to the filing date of the instant application. Therefore, an interference between any of these patents and the current claims is possible provided there exists or can be made an interference-in-fact. Accordingly, Applicant respectfully requests that the Examiner reconsider this point, and advise Applicant whether an interference-in-fact exists or can be made.

In the event that the Examiner still believes his position is correct, new claim 18 is identical to original claim 1, and, therefore, unquestionably entitled to the original filing date.

The Rejections based on the Spector Patents

The instant claims require that "each exposable frame [comprises] a first unexposed portion and a second exposed portion." The Examiner has found this limitation to be met by the Spector patents because they teach "partially exposing" a frame. However, "partially exposing" a frame does not necessarily mean exposing only a part of a frame, for example, a first portion of the frame and then another portion of the same frame. It could also mean exposing the entire frame partially, i.e., less than a full exposure, and then exposing the entire partially exposed frame a second time to complete a full exposure. The former is what Applicant contemplates, and the latter is what Spector contemplates.

In other words, Spector is exposing the ***entire*** frame ***twice.*** Consequently, Spector never has what is required by the instant claims, i.e., "each exposable frame comprising a first unexposed portion and a second exposed portion."

Spector '832 explains quite clearly what is meant by "partially exposing" a frame at column 3, lines 4-9:

> "Each frame in the sequence thereof is partially pre-exposed to produce a latent image of a character. It is essential that the film frame only be partially pre-exposed ***(i.e., half a normal full exposure),*** so that ***the same frame [i.e., the entire frame]*** remains sensitive to light and can be further exposed to photograph the individual. [Emphasis added.]

Then, at column 4, lines 8-16, Spector teaches:

> "Since the film is pre-exposed, ***usually to about one half of its normal full exposure period for taking a picture,*** and the exposure of the film is completed when taking a picture of an individual, the resultant picture would under ordinary circumstances be somewhat underexposed both as to the character and the individual. But by the use of a film of the appropriate sensitivity, this underexposure can be compensated for to provide a picture of good quality. [Again, emphasis added.]"

Spector '224 says the same thing. See, column 4, lines 18-23, wherein it is taught:

> "It is essential that each picture frame be only partially pre-exposed ***(i.e., half a normal full exposure)*** so that the same frame remains sensitive to light and can be further exposed to photograph an individual to produce a picture in which the individual is seen in juxtaposition to the character. [Emphasis added.]"

See, also, column 5, lines 18-26, wherein it is taught:

> "Since the picture in track B is pre-exposed, ***usually to about one-half its normal full exposure period for taking a picture,*** and the exposure of the film is completed when taking a picture of an individual, the resultant picture would under ordinary circumstances be somewhat underexposed. But by the use of a film of the appropriate sensitivity, the underexposure can be compensated for to provide a picture of acceptable quality. [Again, emphasis added.]"

How persons skilled in the art would interpret these teachings of Spector's is readily apparent from Kirkendall '512 at column 2, lines 20-25. Kirkendall writes:

> "The technique used by Spector is ***not*** one of using a mask over a portion of the film unit, but rather exposing the ***whole*** film unit ***twice,*** first by an under-exposure based on light and timing and later by a full exposure of the primary object to be photographed. [Emphasis added.]"

Consequently, Spector '832 and '224 do not, in fact, obtain an "exposable photographic frame comprising a first unexposed portion and a second exposed portion," which is an element of the instant claims. Spector '832 and '224 obtain an exposable photographic frame which is partially exposed over its entire area, but remains capable of further exposure to complete a full exposure.

In view of the foregoing, all of the prior art rejections based on Spector '832 or Spector '224 should be withdrawn.

The Nonobviousness of Packaging

As the proponent of any rejection, the burden is squarely on the Examiner in the first instance to make out a *prima facie* case of obviousness. This requires that the Examiner find in the applied references alone or in their combination a teaching or suggestion of all claim limitations. See, MPEP § 2143 ("[T]he prior art reference (or references when combined) must teach or suggest ***all*** the claim limitations.") There is absolutely no teaching or suggestion in any of the applied references to package the film in a sealed package outside of the camera between exposures. Consequently, this aspect of the present invention could not have been *prima facie* obvious even if, in retrospect, this seems like a pretty simple thing to do.

As stated in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999):

> "Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very

> case with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'...**Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous* application of the requirement for a showing of the teaching or motivation to combine prior art references.** [Emphasis added.]"

Not a single one of the applied references teaches or suggests packaging the film in a sealed package outside of a camera between exposures. Absent such a teaching or suggestion, this aspect of the present invention could not have been *prima facie* obvious as a matter of law even if, in retrospect, this seems simple.

Applicant believes that the foregoing in conjunction with the previously filed response constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Supplemental Amendment under 37 CFR § 1.111 and the attached Mark-Up (12 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 14, 2003

By: _____
Jennifer Archer

ROBERT T. TRICK
USSN 08/100,019

MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO YIELD THE CLAIM AS AMENDED ABOVE

--1. (Thrice Amended) A sealed package of photographic film comprising a plurality of exposable photographic frames to be exposed, each exposable photographic frame comprising a first unexposed portion and a second exposed portion, said sealed package of photographic film being outside of a camera.--

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